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| 10/004,486      | 10/31/2001  | H. Taylor Lamborn    | 10869.56US01        | 9419             |

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EXAMINER

GREEN, ANTHONY J

| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/004,486

Applicant(s)

LAMBORN ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 10-21, 31-39, 54-58, and 66-72 are objected to because of the following informalities:

Applicant needs to use consistent terminology when making reference to the metal pigment particles. In the independent claims applicant recites "metal pigment particles" whereas in the dependent claims applicant recites "metal particles". The phrase "metal particles" found in the dependent claims should be changed to "metal pigment particles" in order to be consistent.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 72 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of an amine-neutralized phosphonic acid salt having a particular formula, does not reasonably provide enablement for the use of any amine-neutralized phosphonic acid salt. The specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The specification teaches the use of a specific amine-neutralized phosphonic acid salt and accordingly this specific salt should appear in the claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-71 and 73-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 23, 40, 47, 59, 74, 77 in the description of "R<sub>1</sub>" applicant uses improper Markush terminology as the term "or" should be -- and --.

Claim 3 is confusing as the groups recited for X and Y differ from those recited in claim 1. Note that claim 1 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 3 recites totally different substituents.

Claim 5 is confusing as the groups recited for R<sub>1</sub> differ from the groups recited in claim 1.

In claim 8 the phrase "the compound" lacks proper antecedent basis as claim 1 does not make reference to a compound.

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Claim 22 is confusing and inconsistent with claim 1 as claim 1 does not recite the presence of a “liquid”. Also it is unclear as to whether or not the phrase “filtering liquid” is meant to be an active method step or another component that is added to the composition.

Claim 25 is confusing as the groups recited for X and Y differ from those recited in claim 23. Note that claim 23 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 25 recites totally different substituents.

Claim 29 is confusing as the groups recited for  $R_1$  differ from the groups recited in claim 23.

Claim 42 is confusing as the groups recited for X and Y differ from those recited in claim 40. Note that claim 40 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 42 recites totally different substituents.

Claim 46 is confusing as the groups recited for  $R_1$  differ from the groups recited in claim 40.

Claim 49 is confusing as the groups recited for X and Y differ from those recited in claim 47. Note that claim 47 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 49 recites totally different substituents.

Claim 53 is confusing as the groups recited for  $R_1$  differ from the groups recited in claim 47.

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Claim 61 is confusing as the groups recited for X and Y differ from those recited in claim 59. Note that claim 59 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 61 recites totally different substituents.

The preambles of Claims 64 and 65 are inconsistent with claim 59 as claim 59 is not directed to a method.

Claim 65 is confusing as the groups recited for R<sub>1</sub> differ from the groups recited in claim 59.

Claim 73 is vague and indefinite as it is unclear as to how an entire automobile would be coated with the coated composition. That is, it would appear that only the metal surfaces of the automobile would be coated with the composition, one would not coat the windows, tires etc.

Claim 76 is confusing as the groups recited for X and Y differ from those recited in claim 74. Note that claim 74 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 76 recites totally different substituents.

Claim 79 is confusing as the groups recited for X and Y differ from those recited in claim 77. Note that claim 77 recites that X and Y are either hydrogen or alkyl, alkenyl, alkynyl, aryl and alkylaryl whereas claim 79 recites totally different substituents.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huybrechts et al (US Patent No. 6,558,796 B2).

The reference teaches, in the claims and column 2, aqueous coating compositions comprising at least one reaction product of (a) at least one phosphonic acid derivative, (b) a compound having 2 epoxy groups and optionally (c) a compound having one epoxy-functional group; and at least one metallic pigment. Column 6, lines 14+ teach that the reaction product may be neutralized with ammonia or amines.

The instant claim is obvious over the reference. While the reference does not specifically teach the formation of an amine-neutralized phosphonic acid salt, it does teach that the phosphonic acid derivative may be amine-neutralized. Accordingly it is within the level of ordinary skill in the art to neutralize the compound of the reference using an amine and thus arrive at the instant invention. "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See In re Van Marter et al 144 USPQ 421; In re Windmer et al 147 USPQ 518, 523; and In re Chapman et al 148 USPQ 711.

#### ***Information Disclosure Statement***

8. The references cited by applicants have been considered, however they are not seen to teach or fairly suggest the instant invention.

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***References Cited By The Examiner***

9. The remaining reference is cited as showing the general state of the art and as such, it is not seen to teach or fairly suggest the instant invention.

***Allowable Subject Matter***

10. Claims 1-71 and 73-79 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, and the claim objections set forth in this Office action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Green whose telephone number is (703) 308-3819. The examiner can normally be reached on Monday - Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone numbers for the Group are as follows:

- (i) (703) 872-9310 for any non-final amendment or communication, and
- (ii) (703) 872-9311 for any after-final amendment or communication.

It is suggested that the examiner be notified that a fax has been sent to ensure prompt handling of the amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**ANTHONY GREEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1755**

ajg  
May 14, 2003